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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/694,860   | 10/29/2003  | Kenneth A. Thomas    | 84820-4402 ADB      | 5712             |
| 530  | 7590        | 10/04/2005           | EXAMINER            |                  |
| LERNER, DAVID, LITTENBERG,<br>KRUMHOLZ & MENTLIK<br>600 SOUTH AVENUE WEST<br>WESTFIELD, NJ 07090 |             |                      | JOLLEY, KIRSTEN     |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 1762                |                  |

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/694,860

Applicant(s)

THOMAS, KENNETH A.

Examiner

Kirsten C. Jolley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 12-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restriction*

1. Applicant's election of Group I, claims 1-11, in the reply filed on July 18, 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 recites the limitation "the *liquid* laminating layer" [emphasis added] in line 2.

There is insufficient antecedent basis for this limitation in the claim.

### *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miekka et al. (US 6,540,865) in view of Xie et al. (US 6,503,620).

Miekka et al. discloses a method for forming a tape comprising: providing a base material having a first surface and a second surface; applying a first layer of a laminating pressure-sensitive adhesive (PSA layer) to cover the first surface of the base material; drying the PSA layer to provide a dry layer; applying a second layer of a melted hot melt adhesive (detackified layer, or DL) on top of the first layer; cooling the second layer to form a solidified layer of hot melt adhesive; forming the tape into a tape width by cutting; and winding the tape into a roll (col. 7, lines 50-57; col. 8, lines 49-51; col. 10, lines 5-7; col. 11, lines 43-62). Miekka et al. also teaches "it may be desirable to tint the DL to avoid having to use a tinted second substrate, or to avoid having to tint the PSA layer as the use of tint in the PSA layer may adversely affect its adhesive properties" (col. 32, lines 34-37). The Examiner notes that while Miekka et al. teaches away from the use of tint, or coloring agent, in the first PSA layer, the reference none-the-less teaches that it is known to use coloring agent in the PSA layer. Alternatively, it would have been obvious for one having ordinary skill in the art to have provided coloring agent in the PSA layer upon seeing the teachings of Miekka et al. with the expected loss of adhesive properties of the PSA layer.

Miekka et al. teaches that the substrate may be in the form of any material suitable to act as a carrier for the construction, and preferred substrates include flexible materials that are sheet stock or roll or web stock (col. 7, lines 28-32). Miekka et al. lacks a specific teaching of applying its adhesive to a polymeric film. Xie et al. is cited for its similar teachings of a facestock material provided with two adhesive layers thereon to form a multilayer PSA

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construction. Xie et al. provides a list of exemplary facestock materials that are suitable flexible materials to form a construction with adhesives applied thereon, including a number of polymeric materials (col. 13, lines 20-43). It would have been obvious for one having ordinary skill in the art, having seen the references of Miekka et al. and Xie et al. in combination, to have used a polymeric material as the base substrate in the method of Miekka et al. with the expectation of successful results since Miekka et al. generally discloses use of conventional flexible materials and is not limiting.

With respect to claim 2, Miekka et al. teaches that the laminate construction may be split lengthwise to form two or more different rolls (col. 8, lines 49-54). It would have been obvious to have wound the tapes into individual supply packages in order to sell them commercially.

As to claim 3, Xie et al. teaches that the polymeric base film may be polyethylene terephthalate in col. 15, lines 41-47.

As to claims 4-5 and 7, Miekka et al. teaches that its construction is then laminated to a second substrate which may be paper (col. 20, lines 21-26 and col. 21). It is the Examiner's position that the shape and end use of Miekka et al.'s construction is a matter of design choice that would be determined by one having ordinary skill in the art.

As to claim 6, Miekka et al. is silent with regard to the thickness of the base film. It would have been obvious for one having ordinary skill in the art to have determined the optimum base film thickness through routine experimentation depending upon the desired end use of the product, in the absence of a showing of criticality.

As to claim 8, Miekka et al. teaches that the first adhesive (PSA) layer may be applied as a liquid including solvent (col. 11, lines 53-62). As to claim 9, it would have been obvious to

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have provided the coloring agent by admixing it with the liquid adhesive because such is a well known method in the coating art for coloring liquid adhesive layers.

As to claim 10, Miekka et al. teaches bonding the hot melt adhesive to a second substrate by heating the adhesive in col. 21, lines 10-18.

As to claim 11, Miekka et al. teaches that the base film preferably has a release material thereon (col. 7, lines 33-35), and the hot melt (DL) adhesive layer may be pressure-sensitive (col. 8, lines 55-58).

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Ugolick et al. (US 5,993,961) and Scholz et al. (US 6,083,338) are cited to demonstrate methods of forming constructions comprising a base film and two adhesive layers applied thereon.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kirsten C. Jolley whose telephone number is 571-272-1421. The examiner can normally be reached on Tuesday to Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Kirsten C Jolley  
Primary Examiner  
Art Unit 1762

kcj